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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,995	02/25/2004	Carl R. Vanderschuit	9053-000119US	6784

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HARNESS, DICKEY, & PIERCE, P.L.C
7700 BONHOMME, STE 400
ST. LOUIS, MO 63105

EXAMINER	
HAN, JASON	

ART UNIT	PAPER NUMBER
2875	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,995	VANDERSCHUIT, CARL R.	
	Examiner	Art Unit	
	Jason M Han	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☒ Claim(s) *4 and 31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/25&5/4 of '04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

a. Page 3, Paragraph 21: illogical error – please delete "(and presently unknown)";

b. Page 5, Paragraph 31: grammatical error – please rewrite "re-usable" as one word;

c. Page 6, Paragraph 31: illogical error – please delete "(and presently unknown)";

Appropriate correction is required.

Claim Objections

2. Claim 4 is objected to because of the following informalities: In line 2 of the claim, the applicant recites the limitation "massage therapy". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

3. Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant merely recites the limitation "emits light having a wavelength within a range of about 680 nanometers and about 880 nanometers", which is found in independent Claim 27.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Landaüer (U.S. Patent 2347915).

5. With regards to Claim 1, Landaüer discloses a therapeutic device providing:

- at least one light source [Column 4, Lines 17-22];
- at least a portion having a non-ambient temperature [Column 4, Lines 9-13]; and
- whereby the light source and non-ambient portion with heat are applied to a user's body for therapy [Column 3, Line 59 – Column 4, Line 63].

6. With regards to Claim 2, Landaüer discloses the therapeutic device providing the light source and non-ambient heat portion concurrently [Column 4, Lines 9-22].

7. With regards to Claim 3, Landaüer discloses the therapeutic device providing a massager that may be applied to a user's body [Column 1, Lines 37-43].

8. With regards to Claim 4, Landaüer discloses the therapeutic device providing the massager (via the electrodes), light source, and non-ambient heat portion simultaneously [Column 4, Lines 5-22].

9. With regards to Claim 5, Landaüer discloses the therapeutic device providing a non-ambient heat portion, which may heat the therapeutic device prior to application on a user's body [Column 4, Lines 9-13].

10. With regards to Claim 7, Landaüer discloses the therapeutic device providing the light source to emit light to a user's body [Column 4, Lines 18-22].

11. With regards to Claim 8, Landaüer discloses the therapeutic device incorporating an attachment device [Figures 1-2: (40)] for applying the non-ambient portion to a user's body [Column 3, Lines 17-32].

12. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker (U.S. Patent 4907132).

13. With regards to Claim 1, Parker discloses a therapeutic device providing:

- at least one light source [Figures 11 or 12: (4)];
- at least a portion having a non-ambient temperature [Figures 11 or 12: (2)]; and
- whereby the light source and non-ambient cold portion are applied to a user's body for therapy [Column 7, Line 63 – Column 8, Line 19].

14. With regards to Claim 6, Parker discloses the therapeutic device providing the non-ambient potion with cooling prior to application to a user's body [Column 8, Lines 10-13].

15. Claims 9, 11, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Landaüer (U.S. Patent 2347915).

16. With regards to Claim 9, Landaüer discloses a therapeutic device including a container [Figures 1-2: (40)], an agent within the container [Column 4, Lines 48-53], and at least one light source for emitting therapeutic light [Column 4, Lines 18-22].

17. With regards to Claim 11, Landaüer discloses the therapeutic device including a massager coupled to the container [Figures 1-2: (44); Column 1, Lines 37-43].

18. With regards to Claim 17, Landaüer discloses the light source disposed within the container [Column 4, Lines 18-22].

19. With regards to Claim 19, Landaüer discloses the therapeutic device incorporating an attachment device [Figures 1-2: (40)] for applying the non-ambient portion to a user's body [Column 3, Lines 17-32].

20. Claims 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Prescott (U.S. Patent 5616140).

21. With regards to Claim 21, Prescott discloses a therapeutic device including at least one light source [Figure 6: (20)] and an adhesive bandage strip [Figure 6: (610)] for attaching the device to a user's body with the light source directed to emit therapeutic light generally towards the user's body [Column 12, Lines 1-4].

22. With regards to Claim 22, Prescott discloses the light source emitting infrared light [Column 5, Lines 30-34].

23. With regards to Claim 23, Prescott discloses the light source emitting light having a wavelength between 680-880 nanometers [Column 5, Lines 1-5].

24. With regards to Claim 24, Prescott discloses the light source including at least one light emitting diode [Figure 6: (20); Column 11, Lines 50-55].

25. Claims 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Altshuler et al. (U.S. Publication 2004/0147984).

26. With regards to Claim 27, Altshuler discloses a therapeutic device including a massager [Figures 12A-B: (1201)], at least one light source [Figure 12: (1202)] that emits light at a wavelength within the range of 680-880 nanometers [Page 10, Paragraph 103; Page 7, Paragraph 79], whereby the light source is positioned relative to the massager to direct therapeutic light generally towards a user's body when the massager is applied to a portion of the user's body.

27. With regards to Claim 28, Altshuler discloses means for providing hot therapy to a user's body [Page 10, Paragraph 103].

28. With regards to Claim 29, Altshuler discloses the therapeutic device having an agent [Figure 12A: 1201] for applying hot therapy to a user's body [Page 10, Paragraph 103].

29. With regards to Claim 30, Altshuler discloses the light source emitting infrared or near infrared light [~700 nm: Page 7, Paragraph 79, whereby infrared lighting is defined between 770nm – 1,000,000nm].

30. With regards to Claim 31, Altshuler discloses the light source emitting light between a wavelength of 680 nm – 880 nm [[~700 nm: Page 7, Paragraph 79].

31. With regards to Claim 32, Altshuler discloses the light source being at least one light emitting diode [Page 7, Paragraph 82].

32. Claims 33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Landaüer (U.S. Patent 2347915).

33. With regards to Claim 33, Landaüer discloses a therapeutic device including a container [Figures 1-2: (40)], means within the container for applying hot therapy [Column 4, Lines 9-13], and means for emitting therapeutic light [Column 4, Lines 18-22].

34. With regards to Claim 34, Landaüer discloses the therapeutic device including means for applying massage therapy [Figures 1-2: (44); Column 1, Lines 37-43].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Landaüer (U.S. Patent 4907132) as applied to Claim 9 above, and further in view of applicant's admitted prior art.

36. With regards to Claim 10, Landaüer discloses the claimed invention as cited above, but does not teach the agent including a hot/cold gel.

Applicant's admitted prior art teaches, "The cavity of the container 104 can be filled (or at least partially filled) with any of a wide range of agents or substances bearing cold-retaining and/or heat-retaining properties such as materials generally used in hot/cold gels, re-usable ice-packs, re-usable heating pads, single use hand warmers,

refreezable liquids or semi-liquids, reheatable liquids or semi-liquids, Insul-Ice reusable ice available from PCM Thermal Solutions, Inc. of Naperville, Illinois, among other suitable known (and presently unknown) materials [Pages 5-6, Paragraph 31; underline added by examiner for emphasis]."

It would have been obvious to modify the therapeutic device of Landaüer to incorporate the hot/cold gel of applicant's admitted prior art in order to provide a substance that preserves either hot/cold temperatures, as well as to accommodate to a user's body via flexibility and cushioning properties that are commonly associated with a gelatin substance. Such a configuration is considered an obvious matter of engineering decision, whereby the agent could have been any of the abovementioned of applicant's admitted prior art while maintaining functional equivalence.

37. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landaüer (U.S. Patent 4907132) as applied to Claim 9 above, and further in view of Altshuler et al. (U.S. Publication 2004/0093042).

38. With regards to Claim 12, Landaüer discloses the claimed invention as cited above, but does not specifically teach the light source emitting infrared or near infrared light.

Altshuler teaches, "Energy source 1 may produce electromagnetic radiation, such as near infrared or visibly light radiation over a broad spectrum, over a limited spectrum or at a single wavelength, such as would be produced by a light emitting diode or a laser [Page 4, Paragraph 45]."

It would have been obvious to modify the therapeutic device of Landaüer to incorporate the infrared or near infrared light source of Altshuler in order to enhance therapeutic effect on a user, whereby it has been found that the modulation of infrared energy at relatively low frequencies, typically in the sonic or sub-sonic range, can provide improved remedial effects for an IR therapy device.

39. With regards to Claim 13, Landaüer in view of Altshuler discloses the claimed invention as cited above. In addition, Altshuler teaches a light source that emits light having a wavelength of about 680 nanometers, as well as about 880 nanometers, depending upon certain depths of tissue and the desired therapeutic effect [Claims 10-11; Table 1].

40. With regards to Claim 14, Landaüer in view of Altshuler discloses the claimed invention as cited above except for a plurality of LEDs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of LEDs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case, mere duplication of a light emitting diode would increase the emitted light to produce a greater intensity for the therapeutic device.

41. With regards to Claim 15, Landaüer in view of Altshuler discloses the claimed invention as cited above except for the light source being removable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the light source removable from the container, since it has been held that constructing a formerly integral structure in various elements involves only routine skill

in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. In this case, it is obvious that one would make the light source removable so as to replace a burnt out bulb or dead light source.

42. With regards to Claim 16, Landaüer in view of Altshuler discloses the claimed invention as cited above. In addition, Altshuler teaches a container defining a sleeve/reflector [Figure 2: (10)] wherein a light source [Figure 2: (9)] is received [Page 6, Paragraph 58].

43. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Landaüer (U.S. Patent 4907132) as applied to Claim 9 above, and further in view of Prescott (U.S. Patent 5616140).

Landaüer discloses the claimed invention as cited above, but does not specifically teach the container having at least one externally flexible portion coupled to a switching device such that movement of the flexible portions connects the light source to a power source.

Prescott teaches, "The power supply and control circuit 26, the operation of which may be initiated by means of a single-pole, double-throw or pressure switch 15, provides power and timing control for operation of the lasers and the hyper-red LEDs [Figure 1: (15); Column 5, Lines 63-66; underline added by examiner for emphasis]."

It would have been obvious to modify the therapeutic device of Landaüer with the pressure switch with an external flexible portion of Prescott in order to provide a user greater flexibility with respect to operation, whereby illumination may be easily turned

on/off at a user's will. Such a configuration is commonly known within the art and considered an obvious matter of engineering decision.

44. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Landaüer (U.S. Patent 4907132) as applied to Claim 19 above, and further in view of Prescott (U.S. Patent 5616140).

Landaüer discloses the claimed invention as cited above, but does not specifically teach the attachment device including an adhesive bandage strip coupled to the container.

Prescott teaches a container [Figure 6: (610)] including an adhesive strip to attach to a user's body [Column 12, Lines 1-4].

It would have been obvious to modify the therapeutic device of Landaüer, and more specifically the attachment device, to incorporate the adhesive strip of Prescott to ensure a strong connection between the device and user's body.

45. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prescott (U.S. Patent 5616140) as applied to Claim 21 above, and further in view of Landaüer (U.S. Patent 4907132).

Prescott discloses the claimed invention as cited above, but does not specifically teach the device including at least one of hot or cold therapy to the user's body (re: Claim 25), nor the device including an agent to facilitate the therapy (re: Claim 26).

Landaüer teaches, "Furthermore, the electrode or housing may be equipped with an electric heater of known construction (not shown) to regulate the temperature of the bath liquid contained in the apparatus housing [Column 4, Lines 9-13]."

It would have been obvious to modify the therapeutic device of Prescott to incorporate the heat therapy of Landaüer to further apply a therapeutic effect on a user. Such heat therapy is commonly known and an obvious matter of engineering decision, wherein a user may experience muscle relaxation from the heat.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references have been cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

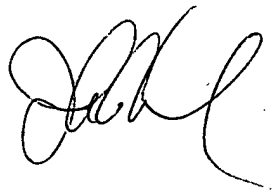
US Patent 4868384 to Franken et al;
US Patent 5358503 to Bertwell et al;
US Patent 5766233 to Thilberg;
US Patent 5800490 to Patz et al;
US Patent 5957960 to Chen et al;
US Patent 6125636 to Taylor et al;
US Patent 6187029 to Shapiro et al;
US Patent 6221095 to Van Zuylen et al;
US Patent 6249698 to Parris;
US Patent 6454789 to Chen et al;
US Patent 6471716 to Pecukonis;
US Publication 2003/0056281 to Hasegawa;
US Publication 2004/0039428 to Williams et al;
US Publication 2004/0249423 to Savage;
US Publication 2004/0260365 to Groseth et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (1/24/2005)



JOHN ANTHONY WARD
PRIMARY EXAMINER